



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,179	02/24/2004	Koji Ishizaki	BD040IT	1144

7590 05/12/2009  
TAKEUCHI & KUBOTERA, LLP  
SUITE 202  
200 DAINGERFIELD ROAD  
ALEXANDRIA, VA 22314

EXAMINER
----------

DICKER, DENNIS T

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

05/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/784,179

**Applicant(s)**

ISHIZAKI, KOJI

**Examiner**

DENNIS DICKER

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see Remarks, filed 2/19/2009, with respect to the rejection(s) of claim(s) 1-19 under 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Momose et al (US 6,301,013).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1, 2, 4, 6-8, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Momose.

As pertaining to **Claim 1**, Momose teaches an image forming apparatus (i.e., **2 of Fig 2, printing device**) comprising: a data collecting section (i.e., **15 of Fig. 2, information management unit**) to reduce data of a plurality of pages and create collected data collected in one single medium (i.e., **Col. 10 lines 52-63, Fig. 8 and Col. 12 lines 50+, reducing pages to fit into a single medium**); a specific information

creating section (i.e., **Fig. 9, mark setting unit**) to create specific information applied to the one single medium (i.e., **Col. 13 lines 15-33, different options when creating specific information [Fig. 9]**); and a data editing section (i.e., **Col. 10 lines 60-63**) to overlap said specific information with said collected data (i.e., **Col. 12 lines 61-Col. 13 line 9 and Col. 16 lines 11+, processing the print information into one page and including the watermark overlapping the plural pages**) so that one single image of the specific information is printed over at least two of the pages (i.e., **Col. 16 lines 1-8, 4 pages are reduced to fit on a single page[Fig. 10] where a watermark is included [See Fig. 9 where the watermark may be positioned at different areas and the colors and density may be adjusted]**).

As pertaining to **Claim 2**, Momose teaches an image forming apparatus which further comprises a setting section to set a parameter according to which said specific information is created (i.e., **73 of Fig. 9 Col. 13 lines 21+, user may select desired watermark**).

With respect to **Claim 4**, Momose teaches an image forming apparatus wherein said setting section sets a position for overlapping said specific information with said collected data (i.e., **Fig. 9**).

With respect to **Claim 6**, Momose teaches an image forming apparatus wherein said setting section sets a color of said specific information (i.e., **Fig. 9**).

With respect to **Claim 7**, Momose teaches an image forming apparatus wherein said setting section sets a density of specific information (i.e., **Fig. 9**).

With respect to **Claim 8**, Momose teaches an image forming apparatus wherein said specific information is data which corresponds to one of said plurality of pages (**i.e., Col. 16 lines 11+, watermark information overlaps pages**).

With respect to **Claim 17**, Momose teaches an image forming apparatus wherein said data collecting section reduces the data of the pages at a first reduction rate (**i.e., Fig. 8, Logical page are reduced based on number of pages indicated by user [Col. 16- lines 1-9]**), said specific information creating section creating the specific information at a second reduction rate different from the first reduction rate (**i.e., Fig. 9, specific information is reduced based on the user at any rate**).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Momose in view of Mori (hereinafter "Mori '179"US 7,027,179).

With respect to **Claim 3**, Momose does not explicitly teach an image forming apparatus wherein said setting section sets a character string of said specific information.

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179, In particular, Mori '179 teaches the use of an image forming

apparatus wherein said setting section sets a character string (i.e., **Col 6 Lines 18-26, User sets desired text string of watermark**) of said specific information.

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a simple reliable manner so that an the device forms images with a plurality of different watermarks based on the print job.

With respect to **Claim 5**, Momose does not explicitly teach an image forming apparatus wherein said setting section sets a rotation angle when overlapping said specific information with said collected data.

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179, In particular, Mori '179 teaches the use of an image forming apparatus wherein said setting section sets a rotation angle (i.e., **Col 6 Line 40 ,Orientation angle of watermark may be set )** when overlapping said specific information with said collected data. (i.e., **Col 2 Lines 13-20, combining unit combines watermark and image data**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a

simple reliable manner so that an the device forms images with a plurality of different watermarks based on the print job.

6. Claims 9, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Momose and further in view of Lapstun et al (hereinafter "Lapstun '000" 6,728,000).

With respect to **Claim 9**, Momose teaches an image forming apparatus (i.e., **2 of Fig 2, printing device**) comprising: an image creating section (i.e., **15 of Fig. 2, information management unit**) to create image data of a plurality of pages (i.e., **Col. 10 lines 52-63, Fig. 8 and Col. 12 lines 50+, reducing pages to fit into a single medium**); a specific information creating section (i.e., **Fig. 9, mark setting unit**) to create specific information overlapped with said image data so that one single image of the specific information (i.e., **Col. 12 lines 61-Col. 13 line 33 and Col. 16 lines 11+, processing the print information into one page and including the watermark overlapping the plural pages**); is printed over at least two of the pages (i.e., **Col. 16 lines 1-8, 4 pages are reduced to fit on a single page[Fig. 10] where a watermark is included [See Fig. 9 where the watermark may be positioned at different areas and the colors and density may be adjusted]**).

Momose does not explicitly teach a specific information inverting section to invert said specific information.

However, the mentioned claimed limitations are well known in the art as evidenced by Lapstun '000, In particular, Lapstun '000 teaches the use of inverting

section (i.e., **Col. 34 Lines 46-47, dither matrix**) to invert said specific information (i.e., **Col. 34 Lines 47-53, Dither matrix is used to create inverted watermarks**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the image forming apparatus of Momose as taught by Lapstun '000 since Lapstun '000 suggested in Col. 34 Lines 54-60 that such a modification would permit secure documents when photocopying.

With respect to **Claim 11**, Momose teaches an image forming apparatus wherein said image creating section is capable of reducing the image data of the page and creating collected data collected in said sheet of said print medium (i.e., **Co. 16 lines 1-9 and Fig. 8, N-up is set and arranged in on physical page**).

With regards to the image forming apparatus of **Claim 18**, the limitations of the claim 18 are corrected by limitation of claim 17 above. The steps of claim 18 read into the function steps of claim 17.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable Momose and Lapstun '000 as applied to Claim 9 and further in view of Hernandez (hereinafter "Hernandez 428" US 6,650,428).

With respect to **Claim 10**, the combination of Momose and Lapstun '000 does not explicitly teach an image forming apparatus wherein said inverted specific information and said image data are created as data which are printed on front and back faces of a sheet of print medium, respectfully .



However, the mentioned claimed limitations are well known in the art as evidenced by Hernandez 428. In particular, Hernandez 428, teaches the use of an image forming apparatus wherein said inverted specific information (i.e., **Col. 3 Line 60, Watermark information**) and said image data (i.e., **Col. 3 Line 62, Relevant material**) are created as data which are printed on front and back faces of a sheet of print medium, respectfully (i.e., **Col. 3 Line 59- Col 4 Line 2, Image data can be printed on one side while the watermark information another side of a print medium**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose and Lapstun '000 as taught by Hernandez 428 since Hernandez 428 suggested in Col. 1 Lines 35-38 that such a modification would permit a method for protecting confidential information using standard paper and a method to distinguish between previously printed sides of multi page document and newly printed sides.

8. Claim 12, 14, 16 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Momose in view of Davidson et al. (hereinafter "Davidson '485" 6,952,485).

With respect to **Claim 12**, Momose teaches an image forming apparatus (i.e., **2 of Fig 2, printing device**) comprising: an image creating section (i.e., **15 of Fig. 2, information management unit**) to create image data of a plurality of pages from document data (i.e., **Col. 10 lines 52-63, Fig. 8 and Col. 12 lines 50+, reducing pages to fit into a single medium**); said specific information (i.e., **Fig. 9, mark setting unit**) being overlapped with said image data so that one single (i.e., **Col. 12 lines 61-**

**Col. 13 line 9 and Col. 16 lines 11+, processing the print information into one page and including the watermark overlapping the plural pages)** of the specific information is printed over at least two of the pages (i.e., **Col. 16 lines 1-8, 4 pages are reduced to fit on a single page[Fig. 10]** where a watermark is included [See Fig. 9 where the watermark may be positioned at different areas and the colors and density may be adjusted]); and a data transmitting section (i.e., **17 of Fig. 2**) to output said specific information and said image data (i.e., **Fig. 2, transfer unit transmits data to printer for output**).

Momose does not explicitly teach an image forming apparatus comprising document information extracting section to extract document information from said document data; a specific information creating section to create specific information from said document information extracted by said document information extracting section.

However, the mentioned claimed limitations are well known in the art as evidenced by Davidson '485, In particular, Davidson '485 teaches the use of an image forming apparatus comprising a document information extracting section (i.e., **Col. 2 Line 30, Encoder Application**) to extract document information from said document data (i.e., **Col. 2 Lines 34-35 , Encoder application extracts data about a document and stores it as metadata**); a specific information creating section to create specific information from said document information (i.e., **Col. 2 Lines 35-38, A watermark is created from another application**) extracted by said document information extracting

section(i.e., **Col. 2 Lines 35-38 , Metadata about document is extracted and included in watermark ).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose as taught by Davidson '485 since Davidson '485 suggested in Col. 8 Lines 6-10 that such a modification would enable the watermark functionality to operate in a manner that is independent of the application program that utilized the driver to send or receive data from an imaging peripheral.

With regards to the image forming apparatus of **Claim 14**, the limitation of the claim 14 are corrected by limitation of claim 11 above. The steps of claim 14 read into the function steps of claim 11.

With respect to **Claim 16**, Momose does not explicitly teach an image forming apparatus wherein said document information is data which can identify a printing person.

However, the mentioned claimed limitations are well known in the art as evidenced by Davidson '485, In particular, Davidson '485 teaches the use of an image forming apparatus wherein said document information (i.e., **Col. 2 Line 36 , Metadata )** is data which can identify a printing person (i.e., **Col. 2 Lines 30-38, Metadata includes user information).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose as taught by Davidson '485 since Davidson '485 suggested in Col. 8 Lines 6-10 that such a

modification would enable the watermark functionality to operate in a manner that is independent of the application program that utilized the driver to send or receive data from an imaging peripheral.

With regards to the image forming apparatus of **Claim 19**, the limitations of the claim 19 are corrected by limitations of claim 17 above. The steps of claim 19 read into the function steps of claim 17.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Momose and Davidson '485 as applied to Claim 12 and further in view of Hernandez '428.

With respect to **Claim 13**, the combination of Momose and Davidson '485 do not teach an image forming apparatus a wherein said extracted specific information and said image data are created as data which are printed on front and back faces of a print medium, respectfully.

However, the mentioned claimed limitations are well known in the art as evidenced by Hernandez 428, In particular, Hernandez 428, teaches the use of an image forming apparatus a wherein said specific information (**i.e., Col. 3 Line 60, Watermark information**) and said image data (**i.e., Col. 3 Line 62, Relevant material**) are created as data which are printed on front and back faces of a print medium, respectfully (**i.e., Col. 3 Line 59-Col 4 Line 2, Image data can be printed on one side while the watermark information another side of a print medium**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose

and Davidson '485 as taught by Hernandez 428 since Hernandez 428 suggested in Col. 1 Lines 35-38 that such a modification would permit a method for protecting confidential information using standard paper and a method to distinguish between previously printed sides of multi page document and newly printed sides.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Momose and Davidson '485 as applied to Claim 12 and further in view of Stefik et al (hereinafter "Stefik '557" 2001/00085557).

With respect to **Claim 15**, the combination of Momose and Davidson '485 do not teach an image forming apparatus a wherein said document data has a specific symbol for extracting said document information.

However, the mentioned claimed limitations are well known in the art as evidenced by Stefik '557, In particular, Stefik '557 teaches the use of image forming apparatus a wherein said document data has a specific symbol (i.e., **Para 0006 , Fingerprint**) for extracting said document information. (i.e., **Para 0081, Fingerprint embedded in watermark marks the document to enable authorized usage**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Momose and Davidson '485 as taught by Stefik '557 since Stefik '557 suggested in Para 0014-0015 that such a modification would provide information associated with that copy of the document and information relating to the rendering event, where the information will typically aid in deterring or preventing unauthorized copying of the rendered work.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS DICKER whose telephone number is (571)270-3140. The examiner can normally be reached on Monday -Thursday 7:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D./  
Examiner, Art Unit 2625  
5/11/2009

/Twyler L. Haskins/  
Supervisory Patent Examiner, Art Unit 2625